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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,331	08/23/2001	Erhard Honig	24759	9981

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EXAMINER	
MUSSER, BARBARA J	
ART UNIT	**PAPER NUMBER**
1733	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,331	HONIG, ERHARD	
	Examiner	Art Unit	
	Barbara J. Musser	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-4 and 7-22* is/are pending in the application.

4a) Of the above claim(s) *12-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 7-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The affidavit filed on 4/19/05 under 37 CFR 1.131 has been considered but is ineffective to overcome the Shanahan et al. reference.

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Shanahan et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The affidavit does not show sufficient evidence of the concept that the roller which forms the strand of material onto the edge of the workpiece also contained projections and recesses which would provide the surface of the extruded strand with ornamentation or a pattern. While step 8) does state the surface can be patterned, it does not indicate which surface is patterned, nor does it link the patterning of the strand with the roller which forms the strand to the edge of the workpiece.

Additionally, all of the claims must be supported by or obvious in view of the evidence provided. While chip or particle board is obvious in view of a wood board, it is uncertain if a board of wood-like particles is obvious in view of a wood board. While the figures clearly show transporting the workpiece past the extrusion means(claim 2), they do not appear to show a stationary support means for the workpiece, clamping means for clamping the workpiece to the support means or a movable member on which the

extrusion means and forming means are transportable along the edge, but rather show moving the workpiece rather than the extruder.(claim 3) They do show pressure means to urge the workpiece against the forming means(5).(claim 4) They also show an adhesive applicator(9) upstream of the strand application location(claim 7) and cooling means(10) for the strand(claim 8) downstream of the application of the decorative foil.(claim 10) However, it does not show a pair of driven wheels arranged that the workpiece is clamped between the wheels(claim 11) since the wheels(3,5) are not disclosed as driven and since the wheel(3) has a different function than clamping. Therefore, claims 3 and 11 are not fully supported by or obvious in view of the affidavit.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shanahan et al.(U.S. Patent 6,231,327).

Shanahan et al. discloses an apparatus for applying a plastic strip to the edge of a plate-like workpiece by extruding the plastic strip on the edge of the workpiece, and

using a forming means having protrusions and recesses to form to form a desired profile via squeezing the plastic between the roller and the edge of the workpiece.(Figure 1)

Regarding claim 2, the reference shows moving the workpiece past the extruder.(Figure 1)

Regarding claim 4, since the workpiece is clamped and moved in relation to the forming roller, it is pressed against the forming roller as the two are pressed together for form the desired pattern.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Munro.

The reference cited above discloses a support means, clamping means, and movable members on which the extruder and forming means are transportable along the edge of the workpiece.(Figure 1) However, the reference does not disclose the workpiece is clamped to a stationary support or that the extruder and forming means are located on a single movable member. Munro discloses a device for applying an edge to a plate-like workpiece wherein the workpiece is stationary and both the extruder and forming means are located on a single movable member.(Abstract; Col. 7, ll. 67-

Col. 8, ll. 3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to clamp the workpiece to a stationary support and locate both the extruder and forming means are located on a single movable member since this would allow the device of Shanahan et al. to be made portable.(Abstract)

Regarding claim 9, Munro discloses applying a band of material to the adhesive laid down by the extruder.(Figure 1) It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a strip of material to the plastic of Shanahan et al. since this would allow the addition of materials which cannot be extruded, such as gold film or wood grained paper, to the edge of the workpiece.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Nakata et al.

The reference cited above does not disclose applying a primer to the workpiece prior to applying the plastic strip. Nakata et al. discloses an apparatus for applying strip of material to the edge of a workpiece wherein primer can be applied to the window edge prior to application of the strip of material.(Col. 6, ll. 48-50) It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an adhesive applicator to apply primer to the edge of the workpiece prior to applying the plastic strip as in Shanahan et al. since it is well-known and conventional in the arts to apply primers to better bond extruded plastic materials to substrates as shown for example by Nakata et al. which discloses applying a primer to the edge of a workpiece prior to applying an extruded plastic material to it.(Col. 6, ll. 48-50)

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Hasenkamp et al.(WO98/04390). U.S. Patent 6,432,237 is considered an English language translation thereof, and all column and line numbers refer to it.

The reference cited above does not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23)

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. and Munro as applied to claim 1 above, and further in view of Hasenkamp et al.

The references cited above do not disclose cooling the strip after application of the decorative material. Hasenkamp et al. discloses it is known when applying thermoplastic to the edge of a workpiece to cool the material so that it does not penetrate too far into the edge of the workpiece.(Col. 3, ll. 16-23) It would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the strip of material applied to the workpiece since this would prevent the material from penetrating too far into the workpiece.(Col. 3, ll. 16-23) While the reference is silent as to when the cooling takes place, one in the art would appreciate that the cooling would

occur after application of the decorative material as otherwise the surface of the adhesive would have cooled too much to allow bonding of the decorative material to the extruded strip.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shanahan et al. as applied to claim 1 above, and further in view of Ecklund et al.

The references cited above do not disclose using a pair of driven rolls to move the workpiece relative to the edge bander. Ecklund et al. discloses it is known to move a workpiece past an extruder which extrudes material on the edge by using a pair of driven rolls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to move the workpiece past the extruder since the device of Nakata et al. would not work well with a material like wood which is not easier held by suction cups and since Ecklund et al. discloses it is known to use driven rollers to move workpieces past an extruder.(Figure 1)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara J. Musser whose telephone number is (571) 272-1222. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571)-272-1156. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJM

SAM CHUAN YAO
PRIMARY EXAMINER